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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,460	12/14/2001	Michael Gauselmann	M-12238-1P US	1710
32566	7590	11/15/2006	EXAMINER	
PATENT LAW GROUP LLP 2635 NORTH FIRST STREET SUITE 223 SAN JOSE, CA 95134			NGUYEN, DAT	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,460

Applicant(s)

GAUSELMANN, MICHAEL

Examiner

Dat T. Nguyen

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11, 13-18, 20, 22, 24-28, 33, 35-39, 41 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 13-18, 20, 22, 24-28, 33, 35-39, 41 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on March 16, 2006 in which applicant amends claims 1 and 24, cancels claims 7-10, 12, 19, 21, 29-32, 34, 40, 42 and 44, and responds to claim rejections. Claims 1-6, 11, 13-18, 20, 22, 24-28, 33, 35-39, 41 and 43 are pending.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 13-15, 18, 20, 22, 24-28, 35, 36, 39, 41 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C 103(a) as obvious over Bennett (US 6,089,977).

The rejection as stated in office action paper no. 11162005 is maintained and incorporated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11, 16, 17, 33, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US 6,439,993) in view of Mayeroff (US 6,224,483).

The rejection as stated in office action paper no. 11162005 is maintained incorporated and modified herein.

Response to Arguments

4. Applicant's arguments filed March 16, 2005 have been fully considered but they are not persuasive.

5. Applicant alleges claims 1 and 24 have been amended to overcome the prior art in replacing the word "any" with the word "all". Examiner respectfully disagrees. The jackpot feature of Bennett not only converts all symbols to the right of the iceberg, but all the symbols in the matrix as illustrated by the penguin's path in figure 3.

6. Applicant states that the feature of Bennett only converts one symbol at a time and that the special symbols are on the leftmost and rightmost reels and that not all

Art Unit: 3714

symbols to the left of the special symbol in the pay line can be converted. As the claims are currently written, examiner respectfully disagrees. Even if applicant's allegation that the feature of Bennett fails to convert all the symbols to the left of the special symbol are converted were true (which is debatable), the argument is moot in relation to the claims since the claims recite converting all the symbols to the left or to the right of the special symbol and since it is obvious that the feature of Bennett converts all of the symbols to the right of the special symbol (Figure 3).

7. Applicant alleges that it is impossible for Bennett to meet the claimed limitations regarding converting all of the symbols to the left of or right of the special symbols. Examiner respectfully disagrees. The feature of Bennett may not convert all of the symbols to the special symbol at one time, but it does convert them all in a sequence prior to the end of the turn and initiation of subsequent turns therefore, one could interpret this action as converting all of the symbols.

8. Applicant alleges O'Halloran teaches only converting symbols in the same pay line as the special symbol and that it is not obvious to alter O'Halloran in such a manner. Examiner respectfully disagrees. It is notoriously well known in the art at the time of invention to have such gaming machines with bent or vertical pay lines; evidence is presented in Mayeroff and Dietz II (US 6,641,477). The presence of bent pay lines would mean that there could be a plurality of pay lines that intersects with said symbol and so substituting for symbols on a win line may translate to substituting for all adjacent symbols.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dat T. Nguyen whose telephone number is 5712722178. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dat Nguyen



JOHN HOTALING, II
PRIMARY EXAMINER